

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of: BUCZEK et al.) Confirmation No.: 1327
)
Application No.: 10/663,320) Group Art Unit: 1762
)
Filed: September 16, 2003) Examiner: JOLLEY, KIRSTEN

For: ARTICLE INCLUDING PARTICLES ORIENTED GENERALLY ALONG AN
ARTICLE SURFACE AND METHOD OF MAKING

REPLY BRIEF UNDER 37 C.F.R. §41.41

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants file this Reply Brief under 37 C.F.R. §41.41 in response to the Examiner's
Answer mailed May 30, 2007.

The Examiner maintains that “[s]ince separation of particles is not discussed in the specification, it appears that the complete particle separation illustrated in Figure 10 is merely an exemplary drawing.” No support for this position has been cited and no legal principle for such a holding has been made. The Examiner admits that Figure 10 shows the claim limitation, but dismisses the application as originally filed, including Figure 10, as merely exemplary. The Examiner therefore relies on an allegation that the specification fails to teach one of ordinary skill in the art to make and use the invention. The Applicants maintain there is sufficient disclosure in the specification, including particle material examples, medium examples, and working examples of combinations of material and medium to teach one of ordinary skill in the art to make a coating having particles physically separated (as shown in the FIGs. 5-10).

The Examiner further submits that the Declarations of Andrew Skoog discussing the methods, including specific examples, suitable for providing the separation and the specific examples recited in the specification, including but not limited to page 12, lines 7-8 in a medium taught at page 14, lines 27-29 or page 12, lines 13-14, fail to show how to make and use the invention. Such argument does not find support in any legal principle, nor has the Examiner supported the position with evidence. The Examiner merely makes the conclusory statement that "[d]ue to the breadth of the claims, the claims are not commensurate in scope with Applicant's arguments or Declarations". The arguments and Declarations point to the examples in the specification, as originally filed, so it is not clear how, nor is it explained, how such the claims are not commensurate in scope with the evidence presented.

The Examiner further makes the conclusory statement "[t]he amount of direction provided by the inventor and the existence of working examples would not be sufficient for one of ordinary skill in the art to achieve the physical separation of particles as claimed without undue experimentation." (page 6) The Examiner has not presented any evidence supporting this position.

In contrast, the Applicant has addressed each of the points argued by the Examiner and maintains the following facts, as supported by evidence and the application as originally filed:

- The figures in the specification, including Figures 5-10, as originally filed, show particles having physical separation.
- A declaration of Andrew Skoog under 37 C.F.R. § 1.132 (Appendix II, Exhibit 1) was filed June 22, 2006 (hereinafter the "1st Declaration") to provide both factual support for the limitation "the particles being physically separated from one another" and evidence that the limitation is enabled by the present invention. Citing the specification, as

originally filed, Declarant Skoog explains, *inter alia*, that the medium material contacts the particle and forms a barrier layer, which impedes particle-to-particle contact and allows movement of the individual particles within the medium (see Paragraph 6 of 1st Declaration).

- Additional evidence that the limitation "the particles being physically separated from one another" is enabled was provided in a second declaration of Andrew Skoog under 37 C.F.R. § 1.132 (Appendix II, Exhibit 1) filed November 3, 2006 (hereinafter referred to as the "2nd Declaration"). Declarant Skoog further explains that a barrier layer, specifically an oxide layer in several of the examples provided in the specification, more specifically an aluminum oxide layer, constitutes the barrier layer and prevents particle-to-particle contact while allowing movement of the individual particles within the medium (see Paragraphs 6 and 7 of the 2nd Declaration).
- The specification, as originally filed, provides specific examples and guidance teaching one of ordinary skill in the art how to make and use the invention, including a specific particle material composition recited at page 6, lines 11-19 (disclosed in U.S. Patent No. 5,827,445) in a medium taught at page 14, lines 27-29 or at page 12, lines 13-14, wherein the combination of the two disclosed in the application as originally filed would result in medium wherein the particles are physically separated.
- The specification, as originally filed, provides at least one working example illustrating the claimed invention (e.g., specification page 12, lines 11-14). These examples, including the specific compounds (e.g., Fe-Co-Al particles) and the methods for assembling the compounds.

As recited in 2164.01(b), "[a]s long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. 112 is satisfied. *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). Failure to disclose other methods by which the claimed invention may be made does not render a claim invalid under 35 U.S.C. 112. *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1533, 3 USPQ2d 1737, 1743 (Fed. Cir.), cert. denied, 484 U.S. 954 (1987)." The above evidence and citations, including those in the specification, as originally filed, shows at least one method for making and using the claimed invention. In fact, the evidence and citations teach several ways (see cited examples above) to make the particles physically separated. Therefore, the Examiner has improperly dismissed the explicit citations in the specification and the evidence provided by Applicant showing and establishing that one of ordinary skill in the art is taught how to make and use the invention, rendering the present specification enabled.

In light of the arguments set forth in the Appeal Brief and the foregoing remarks in reply to the Examiner's Answer, Applicants respectfully request the Board reverse the rejections.

The Commissioner is authorized to charge any fees determined to be due to the undersigned's Account No. 50-1059.

Respectfully submitted,

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Dated: July 11, 2007

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